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EXAMINER

LUONG, VINH

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,102	Applicant(s) LAMPERT ET AL.	
	Examiner Vinh T. Luong	Art Unit 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 3,5 and 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Appendix</u> . |

Art Unit: 3656

1. Applicant's election of the species of FIGS. 1, 2, and 5 in the reply filed on December 7, 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP § 818.03(a).

2. Claims 3, 5, and 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 7, 2009.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because of the implied phrase "[t]he invention relates to . . ." and the legal phraseology "said." Correction is required. See MPEP § 608.01(b).

5. The drawings are objected to because of the reasons, *inter alia*, listed below:

(a) the drawings are not in compliance with 37 CFR 1.84. Please see Form PTO-984 attached to the restriction requirement on September 18, 2009; and

(b) the drawings are inconsistent with the written disclosure. Please see 37 CFR 1.121(e).

For example, 37 CFR 1.84(r) states:

Art Unit: 3656

Arrows may be used at the ends of lines, provided that their meaning is clear, as follows:

- (1) On a lead line, a freestanding arrow to indicate the entire section towards which it points;
- (2) On a lead line, an arrow touching a line to indicate the surface shown by the line looking along the direction of the arrow; or
- (3) To show the direction of movement.

In the instant case, the abstract, specification, and claims disclose the first and second connection points 45 and 46. However, based on 37 CFR 1.84(r) quoted above, in FIG. 1, the arrows at the end of the lines from reference characters 45 and 46 shows the section, surface, or direction of movements instead of the points.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 3656

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, the first and second connection *points* and the screw image in claims 1 and 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

7. The disclosure is objected to because of the informalities, *e.g.*, the specification is inconsistent with the drawings. 37 CFR 1.121(e). The disclosure discloses the first and second connection points 45 and 46. However, FIG. 1 shows the section, surface, or direction of movements 45 and 46. Appropriate correction is required.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1, 2, 4, and 6-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 requires “a first connection *point* (45),” “a second connection *point* (46),” and “a screw *image* for fixation of the gearbox drive unit (1).” (Emphasis added).

The drawings do not show the above claimed features. For example, the attached *Webster’s Third New International Dictionary* defines the “point” as “***a particular narrowly limited part of a surface or of space*** that is singled out as occupying a usu. precisely indicated spot and that has usu. minimum extension or no relevant extension.” (Emphasis added).

Art Unit: 3656

However, FIG. 1 shows the section, surface, or direction of movements 45 and 46 instead of the points as defined by its ordinary and customary meaning in dictionary. It is unclear as to how Applicant made/used the first and second connection *points*. Similarly, it is unclear as to how Applicant made/used the un-illustrated screw image as claimed.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 2, 4, and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, the term “Gearbox drive unit” in claim 1 should have been changed to “A gearbox drive unit.”

The terms “a first connection *point* (45)” and “a second connection *point* (46)” in claim 1 are imprecise since they are inconsistent with the drawings. Please see 37 CFR.1.121(e). The claims call for the points, however, the drawings (FIG. 1) show the section, surface, or direction of movements in accordance with 37 CFR 1.84(r).

The phrases, such as, “*can be* placed” in claims 1 and 6, “*can be* connected” in claims 7 and 8 are vague and indefinite in the sense that things which may be done are not required to be done. For example, in claim 1, the fixing dome *can be*, but is not required structurally to be placed on the first or second connection point. Compare “crimpable” in *In re Collier*, 158 USPQ 266 (CCPA 1968), “discardable” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C.

Art Unit: 3656

Calif. 1986), “removable” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and “comparable” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

Claim 7 recites the limitation “they.” There is insufficient antecedent basis for this limitation in the claim.

It is unclear whether a confusing variety of terms, such as, “a first connection *point* (45),” “a second connection *point* (46),” and “a plurality of connection points (45, 46)” in claim 6/1 refers to the same or different things. Please see MPEP § 608.01(o) and double inclusion in MPEP § 2173.05(o).

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 2, and 6-8, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hager et al. (DE 100 19 512 cited in ¶¶ 2 and 3 of Applicant’s specification).

Please note that DE 100 19 512, which was published on August 23, 2001, *i.e.*, more than one year before the filing date of this application, corresponds to US 6,713,913. In the rejection below, the Examiner uses US 6,713,913 (hereinafter “Hager”) as a translation of DE’512.

Claim 1

Hager teaches a gearbox drive unit 1 (FIG. 1), especially for adjusting movable parts in a motor vehicle, comprising at least one housing part 3 and at least one fixing dome 6 (FIGS. 2a and 2b), which is used to secure the gearbox drive unit 1, characterized in that the housing part 3 comprises a first connection point (at 6 in FIG. 2a, see Appendix hereinafter “App.”) and at least

Art Unit: 3656

one other second connection point (at 15 in FIG. 1, App.), whereon the fixing dome 6 *can be* placed, and that the fixing dome 6 is connected to the housing part 3 at either the first connection point (App.) *or* at the second connection point (App.) according to a screw image (at 4 in FIGS. 3a-3c, App.) for fixation of the gearbox drive unit 1. See Applicant's Spec., ¶¶ 2 and 3; and Hager, c. 3, ll. 29-46.

Claim 1 is anticipated by Hager because Hager teaches the fixing dome being connected to the housing part at the first connection point. See *Brown v. Air Products and Chemicals Inc.*, 60 USPQ2d 501(CAFC 2001) (when the claim recites alternatives, that claim is anticipated by using the prior art that teaches one alternative).

Claim 2

The fixing dome 6 features a projection 12 (FIG. 3c), which engages in a groove (App.) embodied on the electronic housing 16 of the housing part 3 of the gearbox drive unit 1 in order to create the connection between the fixing dome 6 and the housing part 3. Hager, c. 3, ll. 29-46.

Claim 6

The gearbox drive unit (1) includes several fixing domes 6 (FIGS. 2a and 2b) of the same type. A plurality of connection points (first and second connection points) are provided on the housing part 3 of the gearbox drive unit 1, whereon the fixing domes 6 can be placed. The fixing domes 6 are connected to the housing part 3 at selected connection points (FIGS. 2a and 2b, whereby the selected connection points are selected according to the screw image (App.) for fixation of the gearbox drive unit 1.

Claim 7

Art Unit: 3656

At least one other fixing dome (FIG. 2b, App.) is provided and that the fixing dome 6 and the other fixing dome 6 (FIG. 2b, App.) have a common base body 16 so that they can be connected jointly to the housing part 3.

Claim 8

The housing part 3 has, at least in sections, a circular ring-shaped section (FIGS. 1, 2a and 2b, see App.), that the common base body 16 of the fixing dome 6 and of the other fixing dome 6 (FIG. 2b, App.) partially surrounds the circular ring-shaped section (App.) and can be *operatively* connected at the first (App.) and the second connection point (App.) with the circular ring-shaped section (App.).

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claim 4, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Hager.

Art Unit: 3656

Hager teaches that the fixing dome 6 is connected to the housing part 3 of the gearbox drive unit 1 by means of a fastener 4, such as, screws, rivets, or pins. (Hager, c. 6, ll. 23-31).

It is common knowledge in the art to substitute Hager's fastener, such as, screws, rivets, or pins, by the welded connection in order to connect Hager's fixing dome to Hager's housing part. The use of welding as a fastener is notoriously well known. For example, see c. 3, ll. 49-57 in US 6,515,399 issued to Lauf et al., and Description of Prior Art in US 5,045,737 issued to Yamauchi.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the welding as the fastener in order to connect Hager's fixing dome to Hager's housing part as taught or suggested by common knowledge in the art. The modification of Hager's gearbox drive unit by using the welding as the fastener would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement" *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR* at 1739.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Lombardo (housing 14) and Jang (dome 1A).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday, Tuesday, Thursday, and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3656

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/

Primary Examiner, Art Unit 3656